



ATTORNEY DOCKET NO.: DIVER1280-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Short and Keller
Serial No.: 09/685,432
Filed: October 10, 2000
Title: HIGH THROUGHPUT SCREENING FOR SEQUENCES OF INTEREST

Art Unit: 1639
Examiner: J.D. Epperson

Commissioner for Patents
Attn: J.D. Epperson
Group Art Unit No. 1639
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO SUPPLEMENTAL RESTRICTION REQUIREMENT

Sir:

In the Requirement for Restriction mailed January 6, 2003, the Examiner requested restriction to the following species: Subgroup 1, a species of thermophile (claims 1, 8 and 9); Subgroup 2, a species of small molecule (claim 22); Subgroup 3, a species of library (claim 1); Subgroup 4, a species of detectable molecule (claim 4); Subgroup 5, a species of analyzer (claim 5); Subgroup 6, a species of reporter system (claims 10-12 and 20-21); and Subgroup 7, a species of operon (claim 1).

CERTIFICATION UNDER 37 CFR §1.8
I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date, May 20, 2003, in an envelope addressed to: Commissioner for Patents, Attn: J.D. Epperson, Group Art Unit No. 1639, P.O. Box 1450, Alexandria, VA 22313-1450
<div>Cecilia Tobin</div> <div>(Name of Person Mailing Paper)</div>
<div></div> <div>(Signature)</div>

Applicants: Short and Keller
Serial No.: 09/685,432
Filed: October 10, 2000
Page 2

Applicant respectfully traverses the requirement for a ten-way species election in this application (three species elections have already been made in response to the Requirement for Restriction mailed May 30, 2002) because all the methods for identifying a bioactivity or a biomolecule of interest will have to be searched multiple times. Thus, the Examiner will be required to search the same group of references over and over again, causing much waste of time and energy. In addition, the Applicant will be required to file and prosecute multiple applications, entailing much delay and cost that could be avoided by rejoining the species in the claims. However, Applicant understands that this restriction is strictly for search purposes.

Accordingly, Applicants elect alkophile as the species of thermophile for Subgroup 1. Claims 1, 6, and 8 read on Subgroup 1. Applicants elect erythromycin as the species of small molecule for Subgroup 2. Claims 1 and 22 read on Subgroup 2. Applicant elects an expression library as the species of library for Subgroup 3. Claims 1 and 3 read on Subgroup 3. Applicant elects fluorescein as the species of detectable molecule for Subgroup 4. Claims 1, 4, and 20 read on Subgroup 4. Applicant elects FACS as the species of analyzer for Subgroup 5. Claims 1, 5, and 26 read on Subgroup 5. Applicant elects with C₁₂-Fluorescein-Di- β -D-galactopyranoside (C12FDG) as the species of reporter system for Subgroup 6. Claims 1, 10-12, and 20 read on Subgroup 6. Applicant elects a metabolic pathway as the species of operon for Subgroup 7. Claims 1 and 23-25 read on Subgroup 7.

Applicants: Short and Keller
Serial No.: 09/685,432
Filed: October 10, 2000
Page 3

In particular Applicant respectfully requests that the requirement for species election of Subgroups 4, 5, and 6 be reconsidered. Applicant's invention is based on screening a library of clones encode an activity of interest, rather than the device that is utilized for the screening or the fluorescent molecule or reporter system that is used. Any type of flow cytometry device or fluorescent molecule would be useful in the claimed invention and would not require a separate search. In addition, Applicant respectfully requests that all species be rejoined should no prior art be found.

Respectfully submitted,

Date: May 20, 2003



Lisa A. Haile, J.D., Ph.D.
Registration No.: 38,347
Telephone: (858) 677-1456
Facsimile: (858) 677-1465

USPTO CUSTOMER NUMBER 28213
GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133